

TRADEMARK LAW OFFICE 102
Serial Number: 78/002694
Mark: THE ACI GROUP

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**of Response to Office Action ONLY **

Docket: G2119-906603

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re application of

Automation Consultants, Inc.

Serial No.: 78/002,694

Filed: April 5, 2000

For: THE ACI GROUP

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Trademark Attorney: Paula B. Mays

Law Office: 102

McLean, Virginia
February 13, 2002



02-13-2002

U.S. Patent & TMO/TM Mail Rpt Dt. #70

APPLICANT'S REPLY BRIEF

BOX: TTAB

To the Assistant Commissioner of Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513

Sir:

In reply to the Examining Attorney's Appeal Brief (EAAB), dated January 25, 2002, Applicant addresses herein several points raised in the Brief.

Beginning at page 6 of the EAAB, the Examining Attorney presents arguments as to why the services of the parties are very closely related. It is clear from reading this section that the Examining Attorney has improperly relied upon the previous identification of services in reaching the conclusion that the services are closely related. The previous identification is irrelevant to the issue on appeal. This reliance on the

identification as originally presented taints the entirety of the argument presented, and a proper analysis shows that the services are not so closely related that a likelihood of confusion will ensue.

At the point where the Examining Attorney specifically addresses the services which are currently identified in the application, it is stated that:

[T]he registrant's computer design and programming services are sufficiently broad and encompasses [sic] a variety of software development, design and programming services. Such services logically include website design and development.

EAAB, page 8, ¶1.

However, the services identified in the cited registration are directed to computer system services, such as engineering, software design, and programming services, which have their genesis in the design and operation of the computer system itself. In contrast, the website design and development services identified in the present application are directed to developing for a client its on-line presence to all or a portion of the outside world. Such services differ considerably in nature from the services set forth in the cited registration. As such, the services set forth in the registration do not logically include website design and development. Customers or potential customers for the two types of services will readily be able to distinguish between sources, and there will thus be no appreciable level of source confusion in this situation.


It is respectfully submitted that, once the original identification of services in the application is properly put aside, the arguments directed to the alleged close similarity of the services amount to nothing more than the application of a per se rule that the services

are confusingly similar because both relate to services offered in the realm of computers.

Reversal of the refusal under Section 2(d) is thus warranted, and is earnestly solicited.

Respectfully submitted,

MILES & STOCKBRIDGE P.C.

By: 
John C. Kerins
Reg. No. 32,421

1751 Pinnacle Drive, Suite 500
McLean, Virginia 22102-3833
Telephone: (703) 610-8649
#9161963v1

FIAB

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REQUEST FOR ORAL HEARING



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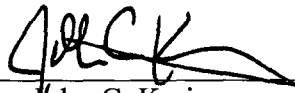
Sir:

Applicant requests an Oral Hearing in the appeal in the above-identified application as provided in 37 CFR §2.142(e)(1).

Please charge any required fees to Deposit Account No. 501165, and a duplicate copy of this paper is attached for deposit account charging purposes.

Respectfully submitted,

MILES & STOCKBRIDGE P.C.

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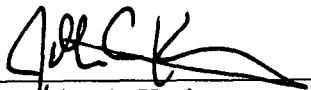
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